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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,930	02/23/2004	Yoshitaka Sasaki	249259US2X	7675
22850	7590	09/21/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				KLIMOWICZ, WILLIAM JOSEPH
ART UNIT		PAPER NUMBER		
2627				

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/782,930	SASAKI ET AL.
	Examiner William J. Klimowicz	Art Unit 2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 August 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
  - 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 and 16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-8 and 16, drawn to thin film magnetic head with a write element, classified in class 360, subclass 126, and the additional election of Specie II, claims 1-8 and 16, corresponding to Figures 7, 8, and 30-38, for further examination on the merits in the present application, in the reply filed on August 9, 2006 is acknowledged. The traversal is on the ground(s) that:

Applicants respectfully traverse the Restriction Requirement because the PTO has not carried forward its burden of proof to establish that searching and examining the noted sets of claims would be an undue burden.

In particular, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area.

Accordingly, Applicants respectfully traverse the outstanding Restriction Requirement on the grounds that a search and examination of the entire application would not place a serious burden on the Examiner. Thus, it is believed that an examination on the merits of Claims 1-16 is in order and it is respectfully requested.

See page 1-2 of the Response filed on August 9, 2006. This is not found persuasive because the Examiner maintains that the product and process inventions are distinct for the reasons given in the previous restriction requirement, i.e., that the Group I claims 1-8 and 16,

drawn to thin film magnetic head with a write element, classified in class 360, subclass 126, and the Group II claims 9-15, drawn to a method of fabricating a thin film magnetic head, classified in class 29, subclass 603.14 are *a priori* distinct, each from the other since Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product could be made by a process not requiring the fabrication steps as articulated in the method claims, including but not limited to: vacuum deposition *and/or* plating deposition *and/or* chemical vapor deposition *and/or* plasma enhanced chemical vapor deposition *and/or* physical vapor deposition *and/or* reactive ion etching *and/or* wet etching *and/or* chemical mechanical polishing *and/or* surface abrading *and/or* thermal ablation *and/or* non-sequential method steps which are not promulgated in the process Grouping, *supra*, *and/or* other well known techniques in the art used in manufacturing disk drives and related components used therein, including magnetic heads.

Moreover, because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Moreover still, the Examiner maintains that all that is required to be shown to demonstrate a materially different process or product is “a viable alternative process or product,” and that “[a]llegations of different process or products need not be documented.” See MPEP

**806.05(f).** The Examiner maintains that the materially different process to make the claimed product of the Applicant, is indeed a viable alternative.

As it pertains to the restriction between the product and process claims, the following should be noted. Where Applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with **37 CFR 1.104**. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of **35 U.S.C. 101, 102, 103** and **112**. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See **MPEP § 821.04(b)**. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of **35 U.S.C. 121** does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See **MPEP § 804.01**.

The traversal as it pertains to the election of Species I versus Species II is on the ground(s) that the claims overlap and would not present a serious burden upon the Examiner.

*Id.* at p. 2. This is not found persuasive because the Examiner maintains that each identified Species and/or Invention grouping, as articulated in the previous Requirement for Restriction, would impose a grave and serious burden upon the Examiner. Moreover, in accordance with **37 CFR 1.104**, to the nature of each distinctly grouped Species and/or Invention grouping, the Examiner must make a thorough study thereof and a thorough investigation of the available prior art relating to the claimed subject matter of each distinctly identified Species and/or Grouping. The examination for each distinct Specie/Grouping must be complete with respect both to compliance of the application with the applicable statutes and rules and to the patentability of the invention as claimed, in addition to matters of form, including **Title 35** to the **United States Code**, sections **101, 102, 103** and **112** to each distinctly grouped invention.

Moreover still, it is noted the process claims are not commensurate in scope with the product claims. That is, the process claim(s), as presently drafted, fail to depend from or otherwise include *all* the limitations of the product claim(s).

Thus, the Examiner has clearly shown that the instant invention can be made by another materially different process(es), and that these delineated processes are indeed a “viable alternative.” In **MPEP 806.05(f)**, which expressly pertains to “Process of Making and Product Made” restriction criteria, it unambiguously states that all that is required to be shown for material difference is “a viable alternative process or product,” and that “[a]llegations of

different process or products need not be documented.” See **MPEP § 806.05(f)** for further details.

Because these inventions are **independent *or* distinct** for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is **PROPER**.

More specifically, as set forth in **MPEP § 803**:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (**MPEP § 806.04 - § 806.04(i)**) **or** distinct (**MPEP § 806.05 - § 806.05(i)**). [Emphasis in bold italics added].

Moreover as set forth in **MPEP § 802.01**, the meaning of independent “and” distinct within the context of Patent Office restriction policy and practice is articulated as follows:

**35 U.S.C. 121** quoted in the preceding section states that the Commissioner may require restriction if two or more “independent and distinct” inventions are claimed in one application. In **37 CFR 1.141**, the statement is made that two or more “independent and distinct inventions” may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This, in turn, depends on the construction of the expression “independent and distinct” inventions.

“Independent,” of course, means not dependent. If “distinct” means the same thing, then its use in the statute and in the rule is redundant. If “distinct” means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that **35 U.S.C. 121**: “enacts as law existing practice with respect to division, at the same time introducing a number of changes.”

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term “independent” as already pointed out, means not dependent. A large number of subjects between which, prior to the **1952 Act**, division had been proper, are dependent subjects, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section **121** of the **1952 Act** were intended to direct the Commissioner never to approve division between dependent inventions, the word “independent” would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term “distinct” with the term “independent,” indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, “distinct” inventions, even though dependent.

Thus, clearly, the restriction is proper if the Examiner shows that the inventions are distinct **or** independent, but not necessarily both independent *and* distinct.

The Examiner *additionally* maintains that each identified Species and/or Invention Grouping, as articulated in the Requirement for Restriction, *supra*, would impose other grave, **serious burdens** upon the Examiner. Moreover, in accordance with **37 CFR 1.104**, to the nature of each distinctly grouped Species and/or Invention Grouping, the Examiner must make a thorough study thereof and a thorough investigation of the available prior art relating to the claimed subject matter of each distinctly identified Species and/or Grouping. The examination for each distinct Specie/Grouping must be complete with respect both to compliance of the application with the applicable statutes and rules and to the patentability of the invention as

claimed, in addition to matters of form, including **Title 35** to the **United States Code**, sections **101, 102, 103** and **112**, to each distinctly grouped invention.

Moreover, each separately grouped specie/invention must be thoroughly searched, including, but not limited to, various searching fields, inclusive of differing text search strategies and/or queries, determination of anticipation, if any, of uncovered prior art, potential application of the Graham factual inquiries to each distinct specie/invention to review for any indicia of possible obviousness, etc.

Moreover still, as has been held, if there is an express admission that the claimed inventions would have been obvious over each other within the meaning of **35 U.S.C. § 103**, restriction should not be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).

***There is nothing on record, at present, to show that the distinctly grouped species/inventions are obvious variants.***

The requirement is still deemed proper and is therefore made **FINAL**.

#### ***Claim Status***

Claims 1-16 are currently pending.

Claims 1-8 and 16 have been considered on the merits, and have been indicated as containing allowable subject matter.

Claims 9-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention/specie, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on August 9, 2006.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Sasaki et al. (US 7,060,207 B2)

The applied reference has a common assignee and inventor(s) with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As per claim 1, Sasaki et al. (US 7,060,207 B2) discloses a thin film magnetic head (Figs. 9-10) with a write element (2), wherein: the write element (2) comprises a first yoke portion (211-214), a second yoke portion (221-222), a first pole portion (P1), a second pole portion (P2), a gap film (24), a back gap portion (216-218, 224) and a coil (231, 232); the first yoke portion (211-214) is connected to the second yoke portion (221, 222) by the back gap portion (216-218,

224) in the opposite side in relation to the medium-facing surface side (52, 53); the first pole portion (P1) and the second pole portion (P2) are disposed in the medium-facing surface side (52, 53) of the first yoke portion (211-214) and the second yoke portion (221, 222) respectively; the first pole portion (P1) includes a trimmed portion in such a position that the trimmed portion faces the second pole portion in the medium-facing surface side - see Fig. 10, and the trimmed portion has a reduced width to fit the second pole portion (P2); the second pole portion (P2) has a reduced width in the medium-facing surface side - Fig. 10; the gap film (24) is disposed between the first pole portion (P1) and the second pole portion (P2); the coil (231, 232) surrounds in a spiral form the back gap portion (216-218, 224); and the first pole portion (P1) includes an extending portion (214/218) that extends so as to cover one surface of the coil (231, 232) facing the second pole portion (P2).

As per claim 2, wherein: the first pole portion (P1) comprises a first pole piece (212), a second pole piece (213) and a third pole piece (214); the first pole piece (212) is formed of an end of a first magnetic film (211) supporting the coil (231, 232); the second pole piece (213) has one surface adjacent to the first pole piece (212); the third pole piece (214) has one surface adjacent to the other surface of the second pole piece (213); the second pole piece (213) is disposed on the medium-facing surface side (52, 53) of the coil (231, 232); the third pole piece (214) includes an extending portion that extends so as to cover said other surface of the second pole piece and said one surface of the coil facing the second pole portion (P2).

As per claim 3, wherein: the first pole portion (P1) further comprises a fourth pole piece (218) having one surface adjacent to the other surface of the third pole piece (214); and extending portions (214 and/or 218) that extend so as to cover one surface of the coil (231, 232)

facing the second pole portion (P2) are at all levels in the height of the third pole piece (214) and at some levels in the height of the fourth pole piece (218) - see Fig. 9.

As per claim 4, wherein: the first pole portion (P1) further comprises a fourth pole piece (218) having one surface adjacent to the other surface of the third pole piece (214); and the extending portion (e.g., 214) that extends so as to cover one surface of the coil (231, 232) facing the second pole portion (P2) is at all levels in the height of the third pole piece (214).

As per claim 5, wherein: the extending portion (e.g., 214) that extends so as to cover one surface of the coil (231, 232) facing the second pole portion (P2) is at some levels in the height of the third pole piece (214).

As per claim 6, wherein: the trimmed portion has a trimming depth that reaches the extending portion of the third pole piece (214) (cf. Figs. 9-10).

As per claim 7, the trimmed portion has a trimming bottom surface on the fourth pole piece (218) - see Fig. 10.

As per claim 8, wherein: the coil (231, 232) comprises a first coil (231) and a second coil (232); the first and second coils (231, 232) surround in a spiral form the back gap portion (216-218, 224), and one of the first (231) and second (232) coils is fitted into the space between coil turns of the other, insulated from the coil turns of the other by an insulating film (252), and the first and second coils (231, 232) are connected to each other so as to generate magnetic flux in the same direction.

As per claim 16, a magnetic recording/reproducing apparatus (e.g., see Fig. 86) comprising the aforescribed thin film magnetic head and a magnetic recording medium (71),

wherein: the thin film magnetic head; and the magnetic recording medium (71) performs magnetic recording/reproducing operations in cooperation with the thin film magnetic head.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (571) 272-7577. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Will J. Klimowicz*  
William J. Klimowicz  
Primary Examiner  
Art Unit 2627

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